



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,486	11/27/2001	Shinichi Watanabe	P20705	8162
7055	7590	01/21/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C.			KOROBV, VITALI A	
1950 ROLAND CLARKE PLACE			ART UNIT	
RESTON, VA 20191			PAPER NUMBER	
			2155	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,486

Applicant(s)

WATANABE ET AL.

Examiner

Vitali Korobov

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/08/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 - 11 are presented for examination.
2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/993486, filed on 11/27/2001.
3. The information disclosure statement (IDS) submitted on 03/08/2002 has been received and considered by the examiner. It is noted that the names of the inventors listed in IDS have been misspelled.

Oath/Declaration

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the applicant's signature is not dated.

Specification

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification

Art Unit: 2155

are: in paragraph 12, paragraph 15 and numerous other paragraphs throughout Specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1 – 7 and 9 - 11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,748,057 by Ranalli et al. (Ranalli).

With respect to claim 1, Ranalli teaches a server apparatus comprising: a receiver that receives electronic mail data (Fig. 1, item 2 and 12); an analyzer that extracts a destination telephone number from the electronic mail data (Fig.

Art Unit: 2155

3, Directory Service (DS)); a memory section that stores data including at least one telephone number and at least one IP address in association with each other (Col. 7. lines 51 – 57); and a transmitter that transmits the electronic mail data to an IP address that is pre-associated with the extracted destination telephone number in accordance with data stored in the memory section (Fig. 1, item 2).

With respect to claim 2, Ranalli teaches the server apparatus according to claim 1, wherein, when the destination telephone number is not stored in the memory, the transmitter informs a sender of the electronic mail data of an error (Col 5, lines 9 - 12 of Ranalli teach the use of SMTP protocol as one possible mode of implementation. The industry standard implementation of SMTP (according to RFC 821, August 13, 1982) provides for error notification if the recipient is not registered (Reply Code 550)).

With respect to claim 3, Ranalli teaches the server apparatus according to claim 1, wherein, upon transmission of the electronic mail data, the transmitter inserts, into the electronic mail data, an ID that is capable of identifying the electronic mail data, as a user name of a sender mail address, and a domain name, indicating delivery confirmation, as a domain name of the sender mail address. (Col 5, lines 9 - 12 of Ranalli teach the use of SMTP protocol as one possible mode of implementation. See SMTP message format according to RFC 822, August 13, 1982, paragraph A.3.3.). See MPEP 2131.01.

With respect to claim 4, Ranalli teaches the server apparatus according to claim 1, wherein the analyzer determines whether a domain name of a

Art Unit: 2155

destination mail address included in the electronic mail data is a domain name indicating delivery confirmation, and, when the domain name of the destination mail address is determined as the domain name indicating delivery confirmation, the analyzer further determines whether transmission of previous electronic mail data has been completed, in accordance with a content of the electronic mail data. (Col 5, lines 9 - 12 of Ranalli teach the use of SMTP protocol as one possible mode of implementation. See SMTP message format according to RFC 822, August 13, 1982, paragraph A.3.3., and Command Semantics 4.1.1., specifying passing of parameters to various commands and message delivery administration).

With respect to claim 5, Ranalli teaches a server apparatus according to claim 1, wherein the analyzer determines whether a domain name of a destination mail address included in the electronic mail data is a domain name indicating delivery confirmation, and, when the domain name of the destination mail address is determined as the domain name indicating delivery confirmation, the analyzer determines that transmission of previous electronic mail data has not been completed normally (Col 5, lines 9 - 12 of Ranalli teach the use of SMTP protocol as one possible mode of implementation. See SMTP specifications, RFC 821, August 13, 1982, Chapter 2, "The SMTP Model", paragraph 5, "reverse-path" and "forward-path" as arguments to RCPT and other message administration commands).

With respect to claim 6, Ranalli teaches a server apparatus according to claim 4, wherein, when the domain name of the destination mail address is

Art Unit: 2155

determined as the domain name indicating delivery confirmation, the transmitter informs a sender of the previous electronic mail data whether the transmission of the previous electronic mail data has been completed, in accordance with an ID, which is included, in the electronic mail data, as a user name of the destination mail address. (Col 5, lines 9 - 12 of Ranalli teach the use of SMTP protocol as one possible mode of implementation. See SMTP specifications, RFC 821, August 13, 1982, Chapter 2, "The SMTP Model", paragraph 5, "reverse-path" and "forward-path" as arguments to RCPT and other message administration commands).

With respect to claim 7, Ranalli teaches a server apparatus according to claim 6, wherein, upon informing the result to the sender of the previous electronic mail data, the transmitter transmits an informing electronic mail data, with a domain name of a sender mail address of the informing electronic mail data indicating discarding. (Col 5, lines 9 - 12 of Ranalli teach the use of SMTP protocol as one possible mode of implementation. See SMTP specifications, RFC 821, August 13, 1982, RSET command).

With respect to claim 9, Ranalli teaches an electronic mail transmission terminal connected to the server apparatus according to claim 1, the electronic mail transmission terminal comprising: an input unit through which the destination telephone number and a transmission instruction are input; and a transmitter that transmits, when the destination telephone number and the transmission instruction are input, an electronic mail data including the destination telephone number to the server apparatus. (Fig. 1, item2).

Art Unit: 2155

Claim 10 is rejected in view of the rejected claims 1 - 9, as differing from said claims only in statutory category. Claim 10 is essentially the same as claims 1 - 9, except that they set forth the invention as a system rather than an apparatus.

Claim 11 is rejected in view of the rejected claim 1, as differing from said claim only in statutory category. Claim 11 is essentially the same as claim 1, except that it sets forth the invention as a method rather than an apparatus.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2155

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ranalli in view of U.S. Patent No. 6,735,617 by Goodman (Goodman).

With respect to Claim 8, Ranalli teaches a server apparatus according to claim 1, wherein the memory section further stores a terminal type in association with each telephone number (Col. 7, lines 35 - 37 and lines 45 - 50). Ranalli fails to explicitly teach said server apparatus, when the destination telephone number is pre-associated with a terminal type indicating a terminal in compliance with H.323 as defined in an ITU-T Recommendation, and the transmitter obtains an IP address of the terminal from an H.323 gatekeeper. Goodman teaches said server apparatus, when the destination telephone number is pre-associated with a terminal type indicating a terminal in compliance with H.323 as defined in an ITU-T Recommendation (Fig. 13), and the transmitter obtains an IP address of the terminal from an H.323 gatekeeper (Col. 2, lines 49 - 54). Ranalli and Goodman are analogous art because they are both related to facsimile transmission over the Internet (T 37 is a FOIP protocol). Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Ranalli by implementing teachings of Goodman. A person of ordinary skills in the art would be motivated to incorporate Goodman in Ranalli in order to enhance resource management capabilities offered by Ranalli by offering an additional capability to manage available resources for call routing via H.323 gatekeepers, since the gatekeeper can act as a logical "switch" of the H.323 network, providing several additional services to all endpoints in its zone.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. 6625258 B1 by Ram et al., September 23, 2003.

The patent teaches a system (VAS) whereby a subscriber is provided with a multitude of services over telephone or data network, and all communications (e-mail, voice mail, fax, etc.) are received via a single telephone number, such as the subscriber has account 8001234567 for calls, voice mail, Fax, IP calls, etc., and 80012345678@VAS.com for e-mail.

U.S. Patent No. US 6757732 B1, by Sollee et al., June 29, 2004.

The invention teaches text-based communications over a data network, using SIP, H.323 or other protocol. A directory lists users in a variety of formats, by a PSTN number, combination of a PSTN number and a proxy address (e.g., 972-555-1234@ctxi300); an IP address (e.g., 47.161.18.72); a SIP address (e.g., 5070. Viking@nortelnetworks.com); a SIP address at a specific IP address (e.g., 5070. Viking@47.161.18.72); or other formats.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vitali Korobov whose telephone number is 571-272-7506. The examiner can normally be reached on Mon-Friday 8a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax

Art Unit: 2155

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vitali Korobov
Examiner
Art Unit 2155

VAK
01/14/2005


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER